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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL A. JOHNSON, CLAYTON A. GEORGE,
PEGGY S. WILLETT and SCOTT R. MEYER

Appeal 2008-4952
Application 08/421,055
Technology Center 1700

Decided:¹ February 24, 2009

Before CHUNG K. PAK, PETER F. KRATZ, and MARK NAGUMO,
Administrative Patent Judges.

PAK, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's
decision rejecting claims 6 through 13, 16 through 24, 26 through 29, and 31

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

through 37, all of the claims pending in the above-identified application.
We have jurisdiction under 35 U.S.C. §6.

We REVERSE for the reasons expressed in the Appeal Brief, the Reply Brief, and below.

Statement of the Case

The subject matter on appeal is directed to “a method of using a melt-flowable sheet material to provide protective and aesthetic features to a surface” (Spec. 1, ll. 10-12). This method, as recited in independent claims 6, 28, and 29 on appeal, requires expressly or impliedly that the melt-flowable composition on the sheet material be in contact with the surface of a step joint or a surface of a vehicle body. Details of the appealed subject matter are recited in representative claim 6 reproduced below:

6. A method for modifying a surface of a step joint in a vehicle body comprising the steps of:
 - (a) placing a sheet material on the surface of the step joint, said sheet material comprising (i) a lower melt-flowable layer comprising a melt-flowable composition, the melt-flowable layer having a thickness in the range of at least about 0.05 mm up to about 25 mm, and (ii) a dimensionally stable film for controlling the melt-flow behavior of said melt-flowable composition, said film having a surface topography and being sufficiently dimensionally stable so as not to melt and flow or exhibit wrinkling when heated to a melt sealing temperature of the melt-flowable composition and subsequently cooled, said sheet material being placed on the surface of the step joint such that said melt-flowable composition contacts said surface of the step joint;
 - (b) heating the sheet material to a melt sealing temperature sufficient to cause said melt-flowable composition to (1) melt, flow and level out over surface imperfections or fill gaps in the step joint, as well as (2) adhere and form a bond to the step joint; and
 - (c) allowing the sheet material and the step joint to cool while substantially retaining said surface topography of said film, wherein the melt-flowable layer is thick enough to provide sufficient material to flow and seal the step joint, the sheet material remains adhered to

the step joint, and topographical or protective features are imparted to the step joint by the sheet material.

As evidence of unpatentability of the claimed subject matter, the Examiner has proffered the following prior art references:

Sato	JP 58-217516 A	Dec. 17, 1983
Schappert	US 4,822,683	Apr. 18, 1989
Matsui	JP 01-152049 A	Jun. 14, 1989
Leatherman '679	US 4,877,679	Oct. 31, 1989
Leatherman '779	US 4,892,779	Jan. 9, 1990
Manser	US 4,920,182	Apr. 24, 1990
Johnson	EP 0 384 598 A1	Aug. 29, 1990
Masaaki	JP 03-273975 A	Dec. 5, 1991

The Examiner has rejected the claims on appeal as follows:

- 1) Claims 6, 8, 16, 17, 19 through 24, and 34 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Masaaki;
- 2) Claims 6, 8, 12, 13, 16, 17, 19 through 24, and 34 under 35 U.S.C. § 103(a) as unpatentable over the disclosure of Masaaki;
- 3) Claims 7, 9, and 28 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Masaaki, Schappert, and Manser;
- 4) Claims 10 and 11 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Masaaki, Leatherman '679, and Leatherman '779;
- 5) Claims 18, 29, 31, 36, and 37 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Masaaki, Manser, and Sato;
- 6) Claim 32 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Masaaki and Johnson;
- 7) Claims 26, 27, and 33 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Masaaki and Matsui; and

8) Claim 35 under 35 U.S.C. § 103(a) as unpatentable over the combined disclosures of Masaaki, Schappert, Manser and Matsui.

ISSUE

The Examiner's anticipation and obviousness determinations are based on findings that Masaaki teaches or would have suggested particularly placing and sufficiently heating a lower melt-flowable composition on a dimensionally stable film to melt and flow the melt-flowable composition to cover and adhere to a surface or a step joint of a vehicle body as recited in claims 6, 28, and 29. (See Ans. 3-23). Thus, the dispositive question raised is: Has the Examiner demonstrated that Masaaki teaches or would have suggested sufficiently heating a particularly placed lower melt-flowable composition on a dimensionally stable film to *melt and flow* the melt-flowable composition to *cover and adhere* to a surface or a step joint of a vehicle body or substrate as recited in claims 6, 28, and 29?

CONCLUSION OF LAW

On this record, we determine that the Examiner has not demonstrated that Masaaki teaches or would have suggested sufficiently heating a particularly placed lower melt-flowable composition on a dimensionally stable film to *melt and flow* the melt-flowable composition to *cover and adhere* to a surface or a step joint of a vehicle body or substrate as recited in claims 6, 28, and 29.

FINDINGS OF FACT

- 1) Masaaki teaches employing a tape having a first layer of hot melt film (4a) having a thickness of about 30-100 micrometers and a second layer of thermosetting viscous resin (4b) corresponding to the claimed dimensionally stable film on the joint of vehicle body plates to prevent rust (*Compare* Masaaki, Abstract and p. 2 *with* Spec. 4).
- 2) Masaaki teaches applying the tape such that the second layer of thermosetting viscous resin (4b), not the hot melt film (4a), contacts a ED coating film on the joint of vehicle plates or the joint itself (p. 6, together with Figs. 1-5).
- 3) Masaaki teaches an optional backing treatment to soften the tape which is hardened upon reaching its ordinary temperature (p. 8).
- 4) According to the Examiner (Ans. 3), “the tape softens (but does not melt) during baking but hardens after cooling to ordinary temperature (translation p. 8)...”
- 5) Masaaki is silent as to placing, melting, and flowing the hot melt film (4a) of its tape directly on the joint or surface of vehicle plates to cover and adhere to the joint or surface of the same, while preventing its thermosetting viscous resin from melting and flowing or wrinkling (See Masaaki generally).
- 6) The Examiner relies on Schappert, Manser, Leatherman ‘679, Leatherman ‘779, Sato, Johnson, and Matsui as evidence for limitations recited in various dependent claims (Ans. 6-13).

PRINCIPLES OF LAW

Under 35 U.S.C. § 102(b), anticipation is established only if “each and every element as set forth in the claim is found, either expressly or inherently, described in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). As stated in our reviewing court in *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999):

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.....” *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268...(Fed. Cir. 1991). “Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.* at 1269...(quoting *In re Oelrich*, 666 F.2d 578, 581...(C.C.P.A. 1981)).

See also *MEHL/Biophile Intern. Corp. v. Milgraum*, 192 F.3d 1362, 1365 (Fed. Cir. 1999) (inherency may not be established by mere probabilities or possibilities).

According to *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740-41 (2007):

[A]nalysis [of whether the subject matter of a claim would have been obvious] need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ....

Nevertheless, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness." *KSR* at 1741-42, *quoting In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Analysis

As indicated *supra*, Masaaki is silent as to placing, melting, and flowing the hot melt film (4a) of its tape directly on the joint or surface of vehicle plates to cover and adhere to the joint or surface of the same. The Examiner has not demonstrated that Masaaki places its hot melt film (4a) *in contact with* the joint or surface of vehicle plates or inherently or necessarily melts the hot melt film to *flow, cover and adhere* to the joint or surface of vehicle plates as required by the claims on appeal. Nor has the Examiner sufficiently articulated why one of ordinary skill in the art would have been led to place its hot melt film (4a) in contact with the joint or surface of vehicle plates or melt and flow the hot melt film to cover and adhere to the joint or surface of the same contrary to the teachings of Masaaki. The Examiner has not relied on the teachings of the remaining references to cure this inadequacy.

For the reasons set forth above and in the Appeal Brief and the Reply Brief, we determine that the Examiner has failed to carry the burden of establishing a *prima facie* case of unpatentability within the meaning of 35 U.S.C. §§ 102(b) and 103(a).

ORDER

The decision of the Examiner is reversed.

REVERSED

Appeal 2008-4952
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